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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,126	04/02/2004	Miles Libbey	08226/1200320-US1	1506
38880	7590	09/10/2007		
Yahoo! Inc. c/o DARBY & DARBY P.C. P.O. BOX 770 Church Street Station NEW YORK, NY 10008-0770			EXAMINER NGUYEN, DUSTIN	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/817,126	LIBBEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dustin Nguyen	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/06/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-30 are presented for examination.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 30 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A carrier wave signal" is being considered as non-statutory subject matter, fails to fall within a statutory category of invention, it is not a machine, and it is clearly not a process, manufacturer nor composition of matter [ Please see MPEP Chapter 2106 ].

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As per claim 5, the limitation of "wherein the auditory challenge" is being considered as indefinite.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benowitz et al. [ US Patent Application No 2003/0236847 ], in view of Wilson [ US Patent Application No 2004/0015554 ].

7. As per claim 1, Benowitz discloses the invention as claimed including a method for managing outbound message usage [ i.e. method for controlling incoming communication such as email to limit receipt of unsolicited and/or unwanted communications ] [ Figure 1A; and paragraph 0003 ], comprising:

determining a count of each recipient for each outbound message associated with a client; if the count of each recipient is at least equal to a limit over at least one period of time [ i.e. restrict a sender to a limited number of email messages over a specified period of time ] [ paragraphs 0108 and 0115 ].

Benowitz does not specifically disclose  
providing a visual challenge to the client; and

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved.

Wilson discloses

providing a visual challenge to the client [ i.e. image-based challenged ] [ Figure 5; Abstract; and paragraphs 0024 and 0077 ]; and

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved [ i.e. add to blocked list if response is not correct ] [ Figure 2; and paragraphs 0053-0059 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Benowitz and Wilson because the teaching of challenge-response in Wilson would provide a mechanism for eliminating or at least greatly reducing the successful transmission of unwanted e-mail while still making it easy and convenient to receive wanted e-mail [ Wilson, paragraphs 0002 and 0022 ].

8. As per claim 2, Wilson discloses if at least one outbound message associated with the client is indicative of spam for at least one recipient, providing the visual challenge to the client [ i.e. spam or unwanted message ] [ Figure 2; and paragraphs 0004, 0022 and 0037 ].

9. As per claim 3, Wilson discloses wherein the visual challenge further comprises an auditory challenge, and wherein until at least one of the visual challenge and the auditory challenge is resolved, disabling the client's outbound message usage [ i.e. audio file or audio clip ] [ paragraphs 0024 and 0080 ].

10. As per claim 5, Wilson discloses wherein the auditory challenge includes at least one sound clip that is filtered to distort the playing of the sound clip for the auditory challenge [ paragraphs 0024 and 0080 ].

11. As per claim 6, Wilson discloses determining another count for each attempt to resolve the visual challenge; and if the other count for each attempt is at least equal to another limit, disabling the client's outbound message usage [ i.e. allow another try if response is not correct ] [ Figure 2; and paragraphs 0063 and 0065 ].

12. As per claim 7, Wilson discloses if the provided visual challenge is unresolved over a predetermined period of time, disabling the client's outbound message usage [ i.e. add to block list ] [ Figure 2; and paragraphs 0053 and 0056 ].

13. As per claim 8, Wilson discloses if the visual challenge is resolved, resetting the count for each recipient of each outbound message associated with the client [ paragraphs 0063 and 0072 ].

14. As per claim 9, Benowitz discloses wherein a type of the message includes at least one type of email, blog, message board, Short Message Service (SMS), Multi-Media Message Service (MMS), and instant messaging (IM) [ Abstract; and paragraphs 0003 and 0006 ].

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15. As per claim 10, Benowitz discloses if the client's outbound message usage is disabled, providing instructions for an out of band communication by the client for re-enabling the client's outbound message usage [ i.e. notify ] [ 221, Figure 1C; and paragraphs 0024 and 0037 ].

16. As per claim 11, Benowitz discloses employing a recipient count statement to determine the count for each recipient for each outbound message associated with the client, wherein the recipient count statement determines at least one of a current hour recipient count, a current daily recipient count, and a total recipient count [ i.e. usage term ] [ paragraphs 0035, 0092, 0108 ].

17. As per claims 12-20, they are rejected for similar reasons as stated above in claims 1-3 and 6-11.

18. As per claims 21-29, they are rejected for similar reasons as stated above in claims 1-3 and 6-11.

19. As per claim 30, it is rejected for similar reasons as stated above in claim 1.

20. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benowitz et al. [ US Patent Application No 2003/0236847 ], in view of Wilson [ US Patent Application No 2004/0015554 ], and further in view of Burrows et al. [ US Patent No 7,149,801 ].

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21. As per claim 4, Benowitz and Wilson do not specifically disclose wherein the visual challenge includes at least one Captcha test. Burrows discloses wherein the visual challenge includes at least one Captcha test [ col 3, lines 19-25; and col 25, lines 36-46 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Benowitz, Wilson and Burrows because the teaching of Burrows would enable to create puzzles that can be solved only by humans, for the purpose of telling humans and computers apart over a network [ Burrows, col 3, lines 19-21 ].

22. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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A handwritten signature in black ink, appearing to read 'Dustin', with a long horizontal stroke extending to the right.